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ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

RE:

U.S. Application

Serial No: 09/462,502

Filed: January 24, 2000

Group: 1772

Inventor: Yasuo KONDO et al.

For: PANEL FOR AIR BAGS AND  
METHOD OF MANUFACTURING THE SAME

SIR:

Attached hereto for filing are the following papers:

PROVISIONAL ELECTION

Our check in the amount of \$--0-- is attached covering any required fees. In the event that any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 CFR 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

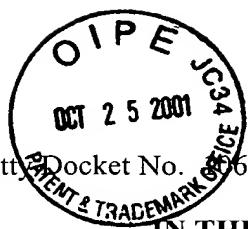
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Atty Docket No. 0641-0001-3 PCT

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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF

Yasuo KONDO et al. : GROUP ART UNIT: 1772

SERIAL NO: 09/462,502 : EXAMINER: C. SIMONE

FILED: JANUARY 24, 2000 :

FOR: PANEL FOR AIR BAGS AND  
METHOD OF MANUFACTURING  
THE SAME

PROVISIONAL ELECTION

ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

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SIR:

In response to the Restriction Requirement dated September 25, 2001, Applicants provisionally elect, with traverse, to continue prosecution on the invention of Group I, claims 1-13 and 19, drawn to a panel for an airbag comprising a joint portion, classified in class 428, subclass 57, and in response to the Election of Species requirement, Applicants provisionally elect, with traverse, to continue prosecution on Species 1, corresponding to the first embodiment of the present invention shown in Figures 1-5 and identify claims 1, 2, 5, and 6 as readable on the provisionally elected species.

In addition to making this election, Applicant respectfully traverses both the Restriction Requirement and the Election of Species requirement as being **improper**.

With respect to the Restriction Requirement, the Office Action alleges that there are four (4) inventions with Groups I, II, and III all being drawn to a product, namely, a panel for an airbag, although the panel for the airbag is said to comprise different elements in each of Groups I, II, and III. Applicants respectfully submit that the inventions of Groups I, II, and

III are all one invention, but are simply claimed in varying manner and scope as is allowed by the U.S. patent practice.

On pages 2 and 3, the Office Action states that the inventions of Group I and II, the inventions of Group II and III, and the inventions of Groups I and III, are unrelated and refers to the Manual of Patent Examining Procedure (hereinafter "MPEP") § 806.04 and § 808.01 for support.

MPEP § 806.04 is entitled "INDEPENDENT INVENTIONS" and states, as follows:

If it can be shown that the two or more inventions are in fact independent, applicant should be required to restrict the claims presented to but one of such independent inventions. For example:

(A) Two different combinations, not disclosed as capable of use together, having different modes of operation, different functions or different effects are independent. An article of apparel such as a shoe, and a locomotive bearing would be an example. A process of painting a house and a process of boring a well would be a second example.

(B) Where the two inventions are process and apparatus, and the apparatus cannot be used to practice the process or any part thereof, they are independent. A specific process of molding is independent from a molding apparatus which cannot be used to practice the specific process.

(C) Where species under a genus are independent, for example, a genus of paper clips having species differing in the manner in which a section of the wire is formed in order to achieve a greater increase in its holding power.

MPEP § 808.01 is entitled "INDEPENDENT INVENTIONS" and states, as follows:

Where the inventions claimed are independent, i.e., where they are not connected in design, operation, or effect under the disclosure of the particular application under consideration (MPEP Section 806.04), the facts relied on for this conclusion are in essence the reasons for insisting upon restriction. This situation, except for species, is but rarely presented, since persons will seldom file an application containing disclosures of independent things.

Form Paragraph 8.20.02 may be used when claims are directed to independent, unrelated inventions.

#### **¶ 8.20.02 Unrelated Inventions**

Inventions [1] and [2] are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects. (MPEP Section 806.04, MPEP Section 808.01). In the instant case the different inventions [3].

**Examiner Note:**

1. This form paragraph is to be used only when claims are presented to unrelated inventions, e. g., a necktie and a locomotive bearing.

2. In bracket 3, insert reasons for concluding that the inventions are unrelated. (Italics and bold-faced print in the original).

It is clear from MPEP § 806.04 and § 808.01 that inventions are only unrelated if they are claiming totally different things, such as given in the examples, for instance, a shoe and a locomotive bearing or a necktie and a locomotive bearing. Thus, it is not seen how Group I, alleged to be drawn to a panel for an airbag comprising a joint portion, Group II, alleged to be drawn to a panel for an airbag comprising a deformation restriction portion, and Group III, alleged to be drawn to a panel for an airbag comprising a crack preventing layer, can be considered to be unrelated, when in fact they are drawn to the same panel for an airbag, albeit in varying scope.

Further, the Office Action even acknowledges that the inventions of Groups I, II, and III have a same common claim when it states that claim 1 is generic in the Election of Species requirement. Applicants respectfully submit that is appears internally inconsistent to say in the Restriction Requirement that the inventions of Groups I, II, and III are unrelated, but then turn around in the Election of Species requirement and say that the inventions of Groups I, II, and III are related as species with a common generic claim 1.

Therefore, Applicants respectfully submit that the inventions of Groups I and II, the inventions of Groups II and III, and the inventions of Groups I and III have not been shown to be “unrelated” or independent inventions in the manner required by M.P.E.P. § 806.04 or § 808.01.

Further, Applicants respectfully submit that the inventions of any one of Groups I, II, and III have not been shown to be distinct from the invention of Group IV in the manner required by M.P.E.P. § 806.05(f) for the reason, as follows:

M.P.E.P. § 806.05(f) requires that the U.S. Patent and Trademark Office (hereinafter “USPTO”) must demonstrate either (1) that the process as claimed is not an obvious process of making the product and the process as claimed can be used to make other and different products, or (2) that the product as claimed can be made by another and materially different process.

Page 2 of the Restriction Requirement indicates that:

“In the instant case the product as claimed in each of the Inventions (I, II, and III) can be made by another and materially different process without the steps of the Group IV process i.e. preparing a thermoplastic material having compatibility as the synthetic resin etc.”

However, this statement does not set forth the specific steps of the process that is simply stated to be “materially different.” At best, there is an indication that a process apparently similar to the process of the Group IV invention, but not including the “preparing a thermoplastic material having a compatibility as the synthetic resin” step, is somehow to be used to make the product as claimed. Because the required showing as to a process (not just a step) to form the product of any one of Groups I, II, and III has not been set forth, Applicants cannot determine what the process being proposed is, much less if it is simply different from the process of Group IV or if it is “materially different” as is required.

Since the Restriction Requirement fails to set forth a process that is even capable of making the product of any one of Groups I, II, and III, it cannot be said to have met the requirement of MPEP §806.05(f) as to showing a “materially different process” for making the product.

Applicants respectfully traverse the Election of Species requirement for the reasons, as follow:

Applicants respectfully submit that the Election of Species requirement is improper. On page 4, lines 1-21, the Office Action clearly recites from paragraph no. 8.01 entitled

“*Election of Species*” which is discussed on page 800-49 of the MPEP (see 8<sup>th</sup> edition, August 2001) in § 809.02(a) entitled “**Election Required.**” Subsection (B) of § 809.02(a) states that the Office Action is to:

Clearly identify each (or in aggravated cases at least exemplary ones) of the disclosed species, *to which claims are restricted*. The species are preferably identified as the species of figures 1, 2, and 3 or the species of examples I, II, and III, respectively. In the absence of distinct figures or examples to identify the several species, the mechanical means, the particular material, or other distinguishing characteristic of the species should be stated for each species identified. If the species *cannot be conveniently identified*, the claims may be grouped in accordance with the species to which they are restricted. (Italics in the original).

In the present case, even though the species could conveniently be identified by figures (see the specification, PREFERRED EMBODIMENTS OF THE INVENTION section, on pages 23-60, which clearly defines Embodiments 1 through 27, and Brief Description of the Drawings section, on pages 18-23, which clearly defines which embodiments are shown in which drawing figures), the Office Action failed to do this. Because no figures were set forth to define the species, the Election of Species requirement is confusing at best and at the very least, a new Office Action should be mailed stating the basis for the Election of Species requirement and listing figures for each species.

In addition, the Office Action merely includes the conclusory statement that “the application contains claims directed to ... patentably distinct species ...” without stating any basis whatsoever in support of such a finding. This is contrary to MPEP §816, which states:

The particular reasons relied on by the examiner for holding the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given. . . .

In the absence of any annunciated basis, it is respectfully submitted that the PTO clearly has not carried forward its burden of proof to establish distinctness.

MPEP § 806.04(f) requires:

Claims to be restricted to different species must be mutually exclusive. . . .

The Office Action fails to address in any way whether the pending claims recite mutually exclusive characteristics and this failure provides a further basis for traversing the election requirement.

MPEP § 803 states:

. . . If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

The claims of the present invention would appear to be part of an overlapping search area.

Accordingly, Applicants also respectfully traverse the Election of Species requirement on the grounds that a search and examination of the entire application would not place a *serious* burden on the Examiner.

In this particular case, since Applicants are at a loss as to the basis of the Election of Species requirement, in view of the fact that the Election of Species requirement does not state any analysis on how the species were decided, Applicants respectfully request that the Election of Species requirement be withdrawn, or at the very least, that a new Office Action be mailed stating the basis for the Election of Species requirement and remedying the deficiencies above-noted, so that Applicants can then appropriately respond on the merits of the requirement.

Accordingly, it is respectfully urged that the Restriction Requirement and Election of Species Requirement should be withdrawn as failing to have established distinctness in the

required manner and that an action on the merits as to all of pending claims 1-20 should be forthcoming.

Respectfully submitted,

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